

### **REMARKS**

Prior to entry of this paper, Claims 1-29 were pending. Claims 1-29 were rejected. In this paper, Claims 1, 5, 9, 14, 16, 18, 19, 21, and 28 are amended. Claims 26 and 27 are cancelled. Claims 1-25, 28, and 29 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

### **Interview Summary**

A telephone interview was held on April 23, 2008. With regard to independent claims 1, 16, and 18, which are rejected as anticipated by Que, Applicants' attorney argued that there is a clear difference between the term "searching" used in the claims, and the term "importing" used in the Que reference. Applicants' attorney also noted that Que does not disclose searching an Exchange archive of emails to find an email address AND adding that email address to an "Exchange" folder within an Outlook address book. The Examiner did not agree or disagree, but instead suggested that Applicants should present the arguments in the written response.

Applicants' attorney also proposed possible amendments to claim 1 explicitly distinguishing between the application that creates the electronic address book and the application of the searched archive. The Examiner reiterated that Que discloses that email addresses can be obtained from different applications such as Exchange, Netscape mail, and Lotus Organizer. Applicants' attorney responded that Que does not disclose searching through Exchange messages, Netscape email messages, or Lotus Organizer email messages and adding a found email address to a folder of the electronic address that is associated with the different application. Que simply imports email addresses from one address book to another address book. The Examiner indicated that Que allows a user to search for a specified email address in an Exchange archive of emails and that Outlook lists public folders within the Outlook application. Applicants' attorney argued that such public folders link to email messages on a server, but are not part of the Outlook address book (e.g., are not folders of contacts within the contact list of a client Outlook application. The Examiner simply again suggested that Applicants should present the amendments and arguments in the written response.

With regard to independent claim 21, which is rejected as anticipated by Tafoya, Applicants' attorney argued that there is a clear difference between the term "language" used in the claims, and the term "email address" used in the Tafoya reference. More specifically, Applicants' attorney argued that Tafoya does not disclose determining a relevance *rating for an email address* based on whether *language* in the email is utilized in outgoing emails. Applicants' attorney noted that the claim uses the terms separately. The examiner asserted that the term "language" can include the term "email address," and asserted that Tafoya discloses that email addresses are in outgoing emails. Applicants' attorney argued that this is not a reasonable interpretation, because the plain meaning of the term "language" is well understood by those of ordinary skill in the art to NOT include an email address. Applicants' attorney noted that those of ordinary skill in the art understand an email address as a destination identifier, not as a word of language. The Examiner referred to a portion of the specification, and argued that the specification does not explicitly exclude the possibility that the term language can include the term "email address." Applicants' attorney argued that Applicants are not required to explicitly define the inclusive and exclusive meanings of every well known term used in the specification according to the plain meaning of such well known terms. No agreement was reached.

With regard to independent claim 9, Applicants' attorney proposed possible amendments that include explicit distinction between the application that creates the electronic address book and the application of the parsed archive. The Examiner reiterated the arguments regarding claim 1, and again suggested that Applicants should present the amendments and arguments in the written response.

Applicants maintain all of the above arguments for the rejections discussed below.

### **Claim Objections**

Claim 5 and 18-19 are objected to because of the following informalities:

Claim 5 recites the limitation, "...includes an organization; organizing the electronic address book according to an organization of at least a portion of the at least one archive..." The OA indicates that it is not clear if it is a new instance of "organization" or a reference to the original organization thus lacks antecedent basis (should be preceded with "said" or "the"). Applicants have

amended claim 5 to remove the second instance of the term “an organization,” and maintain correct consistent use of the term in the claim. Applicants have expressed stated the inherent limitation of determining if the at least one archive includes an organization of emails. Support for the amendments is found throughout the specification, including page 10, lines 14-17 and page 14, lines 10-17.

The OA also indicates that Claim 18 ends with “..with the determined relevancy, and”, it appears to be a unfinished sentence. As discussed below with regard to the rejection of claim 18 under 35 U.S.C. 102(b), Applicants have amended claim 18 to correct the sentence.

Claim 19 recites the limitations “the e-mail address”, “the retrieved e-mail address”, the Examiner suggests using “the e-mail address” as a reference to the same e-mail address (i.e. a retrieved e-mail address) previously introduced in claim 18. Applicants note that claim 18 specifies “a retrieved e-mail address.” Accordingly, Applicants have amended claims 18 and 19 to consistently use “retrieved e-mail address.”

### **Claim Rejections – 35 USC § 101**

#### **Rejections Under 101 to Non-Statutory Subject Matter**

Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the OA indicates that the claims lack physical components and “one of ordinary skill in the art could reasonably interpret the system as software, per se.” OA, page 3. Applicants respectfully disagree. In addition to the fact that the OA admits that claim 16 specifies an apparatus, the specification discloses structure for the means specified in the claim.

For example, the specification states that the “system 120 includes a host 126 that can be implemented through a computer, a plurality of computers . . . one or more processors or a combination of computers, servers and/or processors 130.” Spec., pg. 8, lines 1-5. “The host 126 couples with a distributed network 132, such as the Internet . . .” Spec., pg. 8, lines 8-9. “Typically, the address book builder is run and operated from the host web site through the host device 126 (see FIG. 1).” Spec., pg. 10, lines 28-30. As shown in Figure 2, “[t]he components of the address book builder 150 can be incorporated on a single computer . . . The address book builder includes a

scanner, a searcher or other device 152 . . .” Spec., pg. 9, lines 2-7. Similarly, filter 164, content adder 166, and address book 170 may be devices of the address book builder computer. Further, “[t]he address book builder 150 includes, in some embodiments, a controller 180, such as a microprocessor, a computer, digital signal processor or other similar controllers. The controller 180 can be configured to control the data flow and operation of the components of the address book builder.” Spec., pg. 10, lines 18-23. Thus, at the very least, the components are in a computer memory and executable by microprocessor 180. Because the specification provides structure to support the claims, Applicants respectfully request that the rejection of claims 16 and 17 under 35 U.S.C. 101 be withdrawn.

### **Claim Rejections – 35 USC § 112**

#### **Rejections Under 112 – Failure to Comply with Written Description Requirement**

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the OA indicates that claim 28 specifies a frequency with which an “email” is detected, but a portion of the specification discloses a frequency of use of an “email address.” Applicants have corrected claim 28 to specify a frequency with which the “email address” is detected.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the OA indicates that the claim term “the determined relevance” does not have sufficient antecedent basis. Applicants have removed the term from the claim.

In view of the amendments, Applicants respectfully request that the rejection of claims 28 and 18 under 35 U.S.C. 112 be withdrawn.

### **Claim Rejections – 35 USC § 102**

#### **Rejections Under 102 Over Que**

Claims 1-6 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Que (“Special Edition Using Microsoft Outlook 2000”, Publisher Que, May 17, 2001). Applicants respectfully disagree that Que discloses each and every limitation of each rejected claim. In

addition to the arguments above, and incorporated from prior responses, Applicants respectfully disagree that Que discloses the limitations of searching, over a network, through at least one archive of e-mails for an e-mail address, based on a different application associated with each of the at least one archive.

The OA separates the aspect of searching through emails from the aspect of a different application, and ignores the relationship in the claims of the found email address and the associated application. With regard to searching through emails, the OA indicates that Que discloses searching Outlook messages in folders with your remote Exchange store. See OA, pg. 6, lines 3-11. The OA also argues that "Outlook and Exchange are different applications." OA, pg. 21, lines 12-14.

In addition to arguments incorporated from prior responses, Applicants further argue that, even if for arguments sake only, Outlook and Exchange are considered different applications, Que does not disclose, suggest, or make predictable, searching through an Exchange archive of emails for an email address, based on a different application and adding the e-mail address to the electronic address book, wherein the e-mail address is added to a folder of the electronic address book that is associated with the application that is associated with the at least one archive that is associated with the e-mail address. For the latter limitation, the OA cites portions of Que that disclose importing messages from Exchange. But Que does not disclose, suggest, or make it predicable that such importing imports email *addresses* from Exchange *emails* to an Exchange folder within the *Outlook* address book. Similarly, Que does not disclose, suggest, or make it predicable that Que's importing imports email addresses from Exchange emails to an Exchange folder within an *Exchange* address book. Such importations would be redundant. Thus, Que does not disclose, suggest, or make predictable, adding a found email address to a folder of the electronic address book that is associated with the application that is associated with the at least one archive that is associated with the e-mail address.

Ignoring the limited type of search in Que, it is only the OA that asserts "Outlook users *work with* several other applications and receive files created in other application from other people." Italics added, OA, pg. 6, lines 10-14, citing portions of chapters 18 and 23. In reality, Que simply discloses that a user can "*import* messages and your address book from some other applications." Italics added, Que, pg. 18-1 and see Fig. 18.2. Que does not disclose, suggest, or make predictable,

that such importing involves searching an archive of emails for an email address, based on a different application and adding *the* email address to a folder of the electronic address book that is associated with *the* application that is associated with *the* at least one archive that is associated with *the* e-mail address.

Applicants also respectfully note that the claim limitations are not inherently disclosed by Que. “A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 68 USPQ2d 1186 (Fed. Cir. 2003). There is no reason that the claim limitations are necessary in Que.

For at least the reasons above, Applicants respectfully request that the rejection of independent claims 1, 16, and 18 under 35 U.S.C. 102(b) be withdrawn. It is also well established that dependent claims include the limitations of their corresponding independent claims, and that the dependent claims are patentable for at least the same reasons as their corresponding independent claims. Accordingly, Applicants respectfully request that the rejection of dependent claims 2-6, 17, 19, and 20 under 35 U.S.C. 102(b) also be withdrawn.

Nevertheless, without conceding a change in the scope of the invention, and reserving a right to file a continuing application, Applicants have amended independent claims 1, 16, and 18 to specify that each of the at least one archive of emails is based on a different application. Support for the amendments is found throughout the specification, including page 11, lines 20-25, page 13, line 29 through page 14, line 10, page 15, lines 2-4, page 19, lines 19-24, and page 26, lines 7-10.

Applicants have also amended independent claims 1, 16, and 18 to specify that each application of the at least one archive of emails is different from a first application used to initiate the searching; receive a first defined criteria communicated over the network from a client browser during a communication session with the first application; and create the electronic address book. Support for the amendments is found throughout the specification, including page 12, lines 23-29, page 13, line 29 through page 14, line 5, page 19, lines 13-30, and Figures 3-7.

Applicants have further amended claims 1, 16, and 18 to specify that the first defined criterion limits the selection of the e-mail address based on a prior communication action performed using the e-mail address. Support is found throughout the specification, including page 13,

lines 1-16. In addition, Applicants have amended claims 1, 16, and 18 to specify that the e-mail address is added to a folder within the electronic address book, such that the folder is identified with the application that is associated with the at least one archive that is associated with the e-mail address. Support is found throughout the specification, including page 14, lines 10-17.

In view of the above, respectfully request that the rejection of independent claims 1, 16, and 18 under 35 U.S.C. 102(b) be withdrawn. Because dependent claims are patentable for at least the same reasons as their corresponding independent claims, Applicants respectfully request that the rejection of dependent claims 2-6, 17, 19, and 20 under 35 U.S.C. 102(b) also be withdrawn.

#### Rejections Under 102 Over Tafoya

Claims 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya"). Applicants respectfully disagree that Tafoya discloses each and every limitation of each rejected claim. As discussed above, Applicants respectfully disagree that Tafoya discloses the limitations of determine a relevance rating for the email address based on whether language in the e-mail is utilized in outgoing e-mails.

The OA indicates that Tafoya discloses these limitations by disclosing "(calculate weight reads on relevance rating] include the number of times that the email address or contact has been used for sending, sent usage frequency, Fig. 4B, column 10, lines 28-42, sent e-mail address reads on 'language in the e-mail that is utilized in outgoing e-mails')." OA, page 9, lines 16-18. As asserted by the Examiner in the telephone interview, the OA equates the terms "language in the email" with and "email address." Applicants respectfully disagree that such an equivalence is possible. The well known and plain meaning of an email address refers to an identifier of a delivery address to which an email message can be routed. The well known and plain meaning of "language" in an email refers to words within the email message. Also, those of ordinary skill in the art would not consider the phrase "language in the email" to encompass an email address. Applicants further note that the claim uses the terms separately. The claim specifies parsing the e-mail to obtain an e-mail address. But the claim does not specify determining whether an e-mail address in the e-mail is utilized in outgoing e-mails. Clearly, an e-mail address is not equivalent to, or encompassed within the phrase "language in the e-mail."

Nevertheless, without conceding a change in the scope of the invention, and reserving a right to file a continuing application, Applicants have amended independent claim 21 to include the amended limitations similar to, but different from, claim 1. Support is found throughout the specification, including the locations cited with regard to the amendments to claim 1. Claims 26 and 27 are cancelled in view of the new amendments. In addition to not disclosing a relevance rating based on language in the email and outgoing emails, Tafoya does not disclose, suggest, or make predictable adding an email address to a folder identified with a first one of a plurality of applications that is associated with the email, wherein the outgoing emails are within a second one of the plurality of applications.

For at least the reasons above, Applicants respectfully request that the rejection of independent claim 21 under 35 U.S.C. 102(e) be withdrawn. It is also well established that dependent claims include the limitations of their corresponding independent claims, and that the dependent claims are patentable for at least the same reasons as their corresponding independent claims. Accordingly, Applicants respectfully request that the rejection of dependent claims 22-25 under 35 U.S.C. 102(b) also be withdrawn.

### **Claim Rejections – 35 USC § 103**

#### **Rejections Under 103 Over Harms and Huang**

Claims 9-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms et al. (US Publish 2003/0078981, hereinafter “Harms”) in view of Huang et al. (US Patent No. 5,966,714, hereinafter “Huang”). Applicants maintain and incorporate the arguments made above and in prior responses.

Nevertheless, without conceding a change in the scope of the invention, and reserving a right to file a continuing application, Applicants have amended independent claim 9 to specify that the first defined criteria is received over the network from a client browser during a communication session with a different application that also generates the electronic address book and generates a different archive comprising a different list of email addresses. Support for the amendments is found throughout the specification, including page 11, lines 20-25, page 12, lines 23-29, page 13,



line 29 through page 14, line 5, page 15, lines 2-4, page 19, lines 13-30, page 26, lines 7-10, and Figures 3-7.

Applicants have also amended independent claim 9 to specify that the first retrieved e-mail address is added to a folder of the electronic address book that is associated with the different application. Support for the amendments is found throughout the specification, including page 10, lines 8-17, page 13, line 29 through page 14, line 17, page 24, line 29 through page 25, line 17, and figures 1, 2, and 9. Claim 14 is also amended to conform with amended claim 9.

Harms and Huang do not disclose, suggest, or make predictable the amended limitations. Accordingly, Applicants respectfully request that the rejection of independent claim 9 under 35 U.S.C. 103(a) be withdrawn. It is also well established that dependent claims include the limitations of their corresponding independent claims, and that the dependent claims are patentable for at least the same reasons as their corresponding independent claims. Accordingly, Applicants respectfully request that the rejection of dependent claims 10-13, and 15 under 35 U.S.C. 103(a) also be withdrawn.

#### Rejections Under 103 Over Que and Creswell

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que in view of Creswell et al. (US Patent 6,564,264, hereinafter "Creswell"). Applicants respectfully contend that Creswell does not disclose, suggest, or make predictable, the limitations of corresponding amended independent claim 1 that are missing from Que. Accordingly, Applicants respectfully request that that the rejection of dependent claim 7 under 35 U.S.C. 103(a) be withdrawn.

#### Rejections Under 103 Over Que and Creswell

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que as applied to claim 6 above, and further in view of Harms. Applicants respectfully contend that Creswell does not disclose, suggest, or make predictable, the limitations of corresponding amended independent claim 1 that are missing from Que. Accordingly, Applicants respectfully request that that the rejection of dependent claim 8 under 35 U.S.C. 103(a) be withdrawn.

Rejections Under 103 Over Harms, Huang and Montville

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harms and Huang as applied to claim 12 above, and further in view of Montville et al. (US Patent No. 6,356,937, hereinafter "Montville"). Applicants respectfully contend that Montville does not disclose, suggest, or make predictable, the limitations of corresponding amended independent claim 9 that are missing from Harms and Huang. For example, Montville does not disclose, suggest, or make predictable, the new limitation that the first criterion is received over the network from a client browser during a communication session with a different application that also generates the electronic address book and generates a different archive comprising a different list of email addresses, and wherein the first criterion limits the selection of the retrieved e-mail address based on a prior communication action performed using the retrieved e-mail address. Accordingly, Applicants respectfully request that that the rejection of dependent claim 14 under 35 U.S.C. 103(a) be withdrawn.

Rejections Under 103 Over Que in view of Tafoya

Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Que as in view of Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya"). Applicants maintain and incorporate the arguments made above and in prior responses.

Nevertheless, without conceding a change in the scope of the invention, and reserving a right to file a continuing application, Applicants have amended independent claim 28 to specify that the folder is also identified with the first application. Support for the amendment is found in at least the same locations as those cited for amendments to independent claim 1. Que and Tafoya do not disclose, suggest, or make predictable the limitations that an email address and phone number generated from one application are added to a different application's electronic address book folder that is both associated with a criterion for determining whether to add the email address and phone number, and is identified with the application that generated the email address.

Accordingly, Applicants respectfully request that the rejection of independent claim 28 under 35 U.S.C. 103(a) be withdrawn. It is also well established that dependent claims include the limitations of their corresponding independent claims, and that the dependent claims are patentable for at least the same reasons as their corresponding independent claims. Accordingly, Applicants

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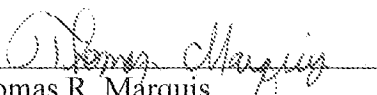
respectfully request that the rejection of dependent claim 29 under 35 U.S.C. 103(a) also be withdrawn.

**CONCLUSION**

It is respectfully submitted that each of the presently pending claims (Claims 1-25, 28, and 29) is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

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